

APR 11 2008

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

combine the applied portions of the relied-upon references are used in rejecting claim 50 in such a manner so as to arrive at the claimed subject matter of claim 50.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 50 is respectfully requested.

27. Claim 51

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 51, in such a manner so as to arrive at the claimed subject matter of claim 51. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 10, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to improve the capacity of video on demand system."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 51 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 51 is respectfully requested.

28. Claim 52

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

By rejecting claims 32, 39-40, 52-53, 64, and 94-95 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 52 states “wherein the subscriber is identified using a media access control address”. The common rejection of claims 32, 39-40, 52-53, 64, and 94-95 as a group makes no mention of “wherein the subscriber is identified using a media access control address”, and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

In addition, the rejection of claim 52 is traversed as moot in view of the present amendments to claim 52. Specifically, claim 52 states, *inter alia*, yet no substantial evidence has

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

been presented that the applied portions of the relied-upon references teach, "the media access control address translated to an Internet Protocol address via a Reverse Address Resolution Protocol".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 52, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 52, in such a manner so as to arrive at the claimed subject matter of claim 52. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would**

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 52 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 52 is respectfully requested.

29. Claim 53

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

By rejecting claims 32, 39-40, 52-53, 64, and 94-95 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. See MPEP 707.07(d) (a "plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.").

For example, unlike the other claims in the rejected group, claim 53 states "wherein the subscriber is identified using an IP address". The common rejection of claims 32, 39-40, 52-53, 64, and 94-95 as a group makes no mention of "wherein the subscriber is identified using an IP address", and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 53, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 53, in such a manner so as to arrive at the claimed subject matter of claim 53. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 53 cannot be sustained based upon the mere conclusory statements of the present Office Action.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 53 is respectfully requested.

30. Claim 54

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 54 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "providing a subscribed channel list for the subscriber that indicates channels which the subscriber is permitted to access". The present Office Action alleges that Rogers teaches this claimed subject matter at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS" (emphasis added). No evidence is of record that one having ordinary skill in the art would have found that a "list" of "programs" teaches a "channel list". Moreover, the applied portion of Rogers is silent regarding any "subscribed" "list" whatsoever.

The applied portions of Monteiro fail to cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 54, and consequently the Office Action fails to establish a *prima facie* case of obviousness.

Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 54 in such a manner so as to arrive at the claimed subject matter of claim 54.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 54 is respectfully requested.

31. Claim 55

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 55 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein data for a channel is received at the computer system and forwarded to the subscriber unit". The present Office Action alleges that Rogers teaches this

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

claimed subject matter at "fig. 7a, step 702". Yet, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. **PROGRAMS**" (emphasis added). No evidence is of record that one having ordinary skill in the art would have found that a "list" of "programs" teaches "data for a channel".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 55, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 55 in such a manner so as to arrive at the claimed subject matter of claim 55.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus,

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 55 is respectfully requested.

32. Claim 56

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Acharya, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 56, in such a manner so as to arrive at the claimed subject matter of claim 56. Regarding the proffered combination of Monteiro, Rogers, and Acharya the present Office Action states, at Page 14, "it would have been obvious to an artisan to apply Acharya's teaching to Rogers's system with the motivation being to provide transmits data as a series of variable length packets, each having a circuit number that identifies its source and destination address."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 56 cannot be sustained based upon the mere conclusory statements of the present Office Action.

c. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 56 is respectfully requested.

33. Claim 57

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 57 in such a manner so as to arrive at the claimed subject matter of claim 57.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 57 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

34. Claim 58**a. Inherency**

Claim 58, from which each of claims 59-74 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach, “receiving from a subscriber unit a request for a list of available channels, **the request including information identifying a subscriber** and being sent using HTTP protocol”.

The present Office Action alleges, at Page 3, that this claimed subject matter is taught by Rogers at “fig.7a, step 701”. Yet, FIG. 7A, step 701 of Rogers merely states, “send call request to switch”. The present Office Action admits that this applied portion of Rogers does not teach “the request including information identifying a subscriber”, yet asserts (emphasis added), “the identity of the subscriber is **inherent** in the request so that the server could be able to send back a list of available program”. No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Rogers. Applicant respectfully requests provision of evidence supporting the assertion that the missing claimed subject matter of “the request including information identifying a subscriber” is necessarily present in the applied portions of Rogers.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

b. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

c. Missing Claim Limitations

By rejecting claims 25, 46, 58, 75, and 81 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. See MPEP 707.07(d)

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

(a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 58 states “the response managed via IP multicast capable TCP/IP software”. The common rejection of claims 25, 46, 58, 75, and 81 as a group makes no mention of “the response managed via IP multicast capable TCP/IP software”, and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

According to paragraphs 21-27 of Dr. Wey’s Declaration, one of ordinary skill in the art would find that claim 58, from which each of claims 59-74 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach or enable, “sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being sent using HTTP protocol and **identifying the IP multicast group assigned to each identified channel**”.

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

applied portions of the relied-upon references, that are used in rejecting claim 58, in such a manner so as to arrive at the claimed subject matter of claim 58. Regarding the proffered combination of Monteiro and Rogers the present Office Action states, at Pages 3-4 "it would have been obvious to an artisan to apply Monteiro's teaching to Roger's system with the motivation being to control which user to receive the real time information."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 58 cannot be sustained based upon the mere conclusory statements of the present Office Action.

e. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 58 is respectfully requested. Reconsideration of each of claims 59-74, each of which ultimately depends from claim 58 is also respectfully requested.

35. Claim 59

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 59, in

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

such a manner so as to arrive at the claimed subject matter of claim 59. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 11 "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system to provide conference over IP."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 59 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 59 is respectfully requested.

36. Claim 60

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 60, in such a manner so as to arrive at the claimed subject matter of claim 60. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 8, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 60 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 60 is respectfully requested.

37. Claim 61

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

b. Missing Claim Limitations

Claim 61 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**". The present Office Action alleges that Rogers teaches this claimed subject matter at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS". Applicant respectfully submits that the applied portion of Rogers is silent regarding a "content provider". Accordingly, no evidence is of record that the applied portions of Rogers teach, "wherein available channels are provided to the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 61, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 61 in such a manner so as to arrive at the claimed subject matter of claim 61.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 61 is respectfully requested.

38. Claim 62

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 62 states, *inter alia*, yet no evidence is presented that the applied portions of Hari teach, "wherein an indication that a channel is made available by a content provider is sent using a session announcement protocol". The applied portion of Hari does not even mention a "session announcement protocol".

No evidence is presented that the applied portions of the remaining relied upon references cure at least these deficiencies of the applied portions of Hari.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 62, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Rogers, Monteiro, and Hari, that are used in rejecting claim 62, in such a manner so as to arrive at the claimed subject matter of claim 62. Regarding the proffered combination of the applied portions of Rogers, Monteiro, and Hari, the present Office Action states, at Page 9, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 62 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 62 is respectfully requested.

39. Claim 63

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

b. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 63, in such a manner so as to arrive at the claimed subject matter of claim 63. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 10, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 63 cannot be sustained based upon the mere conclusory statements of the present Office Action.

c. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 63 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

40. Claim 64**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

b. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 64, in such a manner so as to arrive at the claimed subject matter of claim 64. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 64 cannot be sustained based upon the mere conclusory statements of the present Office Action.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

c. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 64 is respectfully requested.

41. Claim 65

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 65, in such a manner so as to arrive at the claimed subject matter of claim 65. Regarding the proffered combination of Monteiro, Rogers, and Alexanders the present Office Action states, at Page 7, "it would have been obvious to provide data over ATM network unicastly."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 65 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 65 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

42. Claim 66

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

b. Inherency

Claim 66 states, *inter alia*, yet no evidence is of record that the applied portions of the relied-upon reference teach, "wherein the channel source address is an ATM virtual path and transmission circuit". The present Office Action alleges, at Page 7 (emphasis added):

Alexander (6,324,163) discloses wherein the channel source address is an ATM virtual path and transmission circuit (col.2, lines 40-44 wherein the VCC is ATM virtual path and the transmission circuit is **inherent** in the transmit functionality as when the data being transmitted to a destination-emphasis added).

No evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Alexander. Applicant respectfully requests provision of evidence supporting the assertion that the admittedly missing claimed subject matter is necessarily present in Alexander and not merely probably or possibly present.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the "missing descriptive material is necessarily present, not merely probably or possibly present", in any prior art reference cited to support such rejection.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 66, in such a manner so as to arrive at the claimed subject matter of claim 66. Regarding the proffered combination of Monteiro, Rogers, and Alexanders the present Office Action states, at Page 7, "it

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

would have been obvious to apply Alexander's teaching to Rogers's system with the motivation being to provide data over ATM network unicastly."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 66 is respectfully requested.

43. Claim 67

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 67, in such a manner so as to arrive at the claimed subject matter of claim 67. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 13, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide a conference to only the requested client."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 67 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 67 is respectfully requested.

44. Claim 68

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 68 in such a manner so as to arrive at the claimed subject matter of claim 68.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 68 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

45. Claim 69

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

Claim 69 states, *inter alia*, "wherein the subscriber unit is connected to the computer system via a DSL connection." The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 69, in such a manner so as to arrive at the claimed subject matter of claim 69. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 9, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to improve the capacity of video on demand system."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 69 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 69 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

46. Claim 70

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 70 in such a manner so as to arrive at the claimed subject matter of claim 70.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 70 is respectfully requested.

47. Claim 71**a. Prima Facie Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

b. Missing Claim Limitations

Claim 71 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein data for a channel is received at the computer system and forwarded to the subscriber unit". The present Office Action alleges that Rogers teaches this

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

claimed subject matter at "fig. 7a, step 702". Yet, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS" (emphasis added). No evidence is of record that one having ordinary skill in the art would have found that a "list" of "programs" teaches a "channel".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 71, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 71 in such a manner so as to arrive at the claimed subject matter of claim 71.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus,

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 71 is respectfully requested.

48. Claim 72

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Acharya, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 72, in such a manner so as to arrive at the claimed subject matter of claim 72. Regarding the proffered combination of Monteiro, Rogers, and Acharya the present Office Action states, at Page 14, "it would have been obvious to an artisan to apply Acharya's teaching to Rogers's system with the motivation being to provide transmits data as a series of variable length packets, each having a circuit number that identifies its source and destination address."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

of obviousness. The rejection of claim 72 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 72 is respectfully requested.

49. Claim 73

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 73, in such a manner so as to arrive at the claimed subject matter of claim 73. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 13, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide packets only to the requested client over the multicast IP network."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 73 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 73 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

50. Claim 74

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 74 in such a manner so as to arrive at the claimed subject matter of claim 74.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 74 is respectfully requested.

51. Claim 75

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

By rejecting claims 25, 46, 58, 75, and 81 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 75 states “the response managed via IP multicast capable TCP/IP software”. The common rejection of claims 25, 46, 58, 75, and 81 as a group makes no mention of “the response managed via IP multicast capable TCP/IP software”, and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

According to paragraphs 21-27 of Dr. Wey’s Declaration, one of ordinary skill in the art would find that claim 75, from which each of claims 76-80 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach or enable, “sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being sent using HTTP protocol and **identifying the IP multicast group assigned to each identified channel**”.

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 75, in such a manner so as to arrive at the claimed subject matter of claim 75. Regarding the proffered combination of Monteiro and Rogers the present Office Action states, at Pages 3 and 4 "it would have been obvious to an artisan to apply Monteiro's teaching to Roger's system with the motivation being to control which user to receive the real time information."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 75 cannot be sustained based upon the mere conclusory statements of the present Office Action.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

e. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 75 is respectfully requested. Reconsideration of each of claims 76-80, each of which ultimately depends from claim 75 is also respectfully requested.

52. Claim 76

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 76, in such a manner so as to arrive at the claimed subject matter of claim 76. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 8, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 76 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 76 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

53. Claim 77

The present Office Action fails to present grounds for the purported rejection of claim 77. Applicant declines to speculate regarding what grounds might have been intended.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 77 is respectfully requested.

54. Claim 78

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 78 in such a manner so as to arrive at the claimed subject matter of claim 78.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 78 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

55. Claim 79

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 79, in such a manner so as to arrive at the claimed subject matter of claim 79. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 10, "would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to improve the capacity of video on demand system."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 79 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 79 is respectfully requested.

56. Claim 80**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

b. Missing Claim Limitations

Claim 80 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein data for a channel is received at the computer system and forwarded to the subscriber unit". The present Office Action alleges that Rogers teaches this claimed subject matter at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS" (emphasis added). No evidence is of record that one having ordinary skill in the art would have found that a "list" of "programs" teaches a "channel".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 80, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 80 in such a manner so as to arrive at the claimed subject matter of claim 80.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 80 is respectfully requested.

57. Claim 81

a. Inherency

Claim 81, from which each of claims 82-100 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach, "receiving from a subscriber unit a request for a listing of available channels, **the request including information identifying a subscriber**".

The present Office Action alleges, at Page 3, that this claimed subject matter is taught by Rogers at "fig.7a, step 701". Yet, FIG. 7A, step 701 of Rogers merely states, "send call request to switch". The present Office Action admits that this applied portion of Rogers does not teach "the request including information identifying a subscriber", yet asserts (emphasis added), "the identity of the subscriber is **inherent** in the request so that the server could be able to send back a list of available program". No evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Rogers. Applicant respectfully requests provision of evidence supporting the assertion that the missing claimed subject matter of "the request including information identifying a subscriber" is necessarily present in the applied portions of Rogers.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

b. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

c. Missing Claim Limitations

By rejecting claims 25, 46, 58, 75, and 81 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. See MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 81 states “the response managed via IP multicast capable TCP/IP software”. The common rejection of claims 25, 46, 58, 75, and 81 as a group makes no mention of “the response managed via IP multicast capable TCP/IP software”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In addition, claim 81 states, *inter alia*, “via a channel server, sending to the subscriber unit a response via session announcement protocol with an indication of the identified channels”.

The common rejection of claims 25, 46, 58, 75, and 81 as a group makes no mention of “via a channel server, sending to the subscriber unit a response via session announcement protocol with an indication of the identified channels”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

According to paragraphs 21-27 of Dr. Wey’s Declaration, one of ordinary skill in the art would find that claim 81, from which each of claims 82-100 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach or enable, “sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

sent using HTTP protocol and identifying the IP multicast group assigned to each identified channel”.

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what “the pertinent art” is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

e. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 81, in such a manner so as to arrive at the claimed subject matter of claim 81. Regarding the proffered combination of Monteiro and Rogers the present Office Action states, at Pages 3 and 4 “it would have been obvious to an artisan to apply Monteiro’s teaching to Roger’s system with the motivation being

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

to control which user to receive the real time information.”

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 81 cannot be sustained based upon the mere conclusory statements of the present Office Action.

f. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 81 is respectfully requested.

58. Claim 82

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 82, in such a manner so as to arrive at the claimed subject matter of claim 82. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 11 “it would have been obvious to an artisan to apply DeSimone’s teaching to Rogers’s system to provide conference over IP.”

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 82 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 82 is respectfully requested.

59. Claim 83

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 83, in such a manner so as to arrive at the claimed subject matter of claim 83. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 8, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 83 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 83 is respectfully requested.

60. Claim 84

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 84 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**". The present Office Action alleges that this claimed subject matter is taught by Rogers at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS". The applied portion of Rogers is silent regarding a "content provider". Consequently, no evidence is of record that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 84, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 84 in such a manner so as to arrive at the claimed subject matter of claim 84.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 84 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

61. Claim 85

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 85 states, *inter alia*, yet the applied portions of Hari fail to teach, “wherein an indication that a channel is made available by a content provider is sent using a session announcement protocol”. The applied portion of Hari does not even mention a “session announcement protocol”.

No evidence is of record that the applied portions of the remaining relied upon references cure at least these deficiencies of the applied portions of Hari.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 85, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 85, in such a manner so as to arrive at the claimed subject matter of claim 85. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 9, “it would

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 85 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 85 is respectfully requested.

62. Claim 86

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 86, in such a manner so as to arrive at the claimed subject matter of claim 86. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 10, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the

APR 11 2008

PATENT

Application 09/843,289

Attorney Docket 2005P12928US (1120-005)

motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 86 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 86 is respectfully requested.

63. Claim 87

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide grounds of rejection for the claimed subject matter of claim 87. Applicant declines to speculate regarding what the intended grounds of rejection might have been.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 87 is respectfully requested.

64. Claim 88

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 88, in such a manner so as to arrive at the claimed subject matter of claim 88. Regarding the proffered combination of Monteiro, Rogers, and Alexanders the present Office Action states, at Page 7, "it would have been obvious to provide data over ATM network unicastly."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 88 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 88 is respectfully requested.

65. Claim 89

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

b. Inherency

Claim 89 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon reference teaches, “wherein the channel source address is an ATM virtual path and transmission circuit”.

The present Office Action asserts, at Page 7 (emphasis added):

Alexander (6,324,163) discloses wherein the channel source address is an ATM virtual path and transmission circuit (col.2, lines 40-44 wherein the VCC is ATM virtual path and the transmission circuit is **inherent** in the transmit functionality as when the data being transmitted to a destination-emphasis added).

No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Alexander. Applicant respectfully requests provision of evidence supporting the assertion that the admittedly missing claimed subject matter is necessarily present and not merely probably or possibly present in Alexander.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 89, in such a manner so as to arrive at the claimed subject matter of claim 89. Regarding the proffered combination of Monteiro, Rogers, and Alexanders the present Office Action states, at Page 7, “it would have been obvious to apply Alexander’s teaching to Rogers’s system with the motivation being to provide data over ATM network unicastly.”

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 89 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 89 is respectfully requested.

66. Claim 90

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 90, in such a manner so as to arrive at the claimed subject matter of claim 90. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 13, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide a conference to only the requested client."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 90 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 90 is respectfully requested.

67. Claim 91

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 91 in such a manner so as to arrive at the claimed subject matter of claim 91.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason **that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 91 is respectfully requested.

68. Claim 92

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

Claim 92 states, *inter alia*, "wherein the subscriber unit is connected to the computer system via a DSL connection." The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 92, in such a manner so as to arrive at the claimed subject matter of claim 92. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 10, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to improve the capacity of video on demand system."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 92 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 92 is respectfully requested.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

69. Claim 93

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 93 in such a manner so as to arrive at the claimed subject matter of claim 93.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 93 is respectfully requested.

70. Claim 94**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

b. Missing Claim Limitations

By rejecting claims 32, 39-40, 52-53, 64, and 94-95 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 94 states “wherein the subscriber is identified using a media access control address”. The common rejection of claims 32, 39-40, 52-53, 64, and 94-95 as a group makes no mention of “wherein the subscriber is identified using a media access control address”, and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 94, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 94, in such a manner so as to arrive at the claimed subject matter of claim 94. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, “it would have been obvious to an artisan to apply DeSimone’s teaching to Rogers’s system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service.”

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 94 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 94 is respectfully requested.

71. Claim 95

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

By rejecting claims 32, 39-40, 52-53, 64, and 94-95 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a "plurality of claims should never be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.").

For example, unlike the other claims in the rejected group, claim 95 states "wherein the subscriber is identified using an IP address". The common rejection of claims 32, 39-40, 52-53, 64, and 94-95 as a group makes no mention of "wherein the subscriber is identified using an IP address", and fails to point out where, in any of the references, that claimed subject matter is

APR 11 2008

PATENT

Application 09/843,289

Attorney Docket 2005P12928US (1120-005)

disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 95, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 95, in such a manner so as to arrive at the claimed subject matter of claim 95. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 95 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 95 is respectfully requested.

72. Claim 96

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 96 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "providing a subscribed channel list for the subscriber that indicates channels which the subscriber is permitted to access". The present Office Action alleges that Rogers teaches this claimed subject matter at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. **PROGRAMS**" (emphasis added). No evidence is of record that one having ordinary skill in the art would have found that a "list" of "programs" teaches a "channel list". Moreover, the applied portion of Rogers is silent regarding any "subscribed" "list" whatsoever.

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

attempted to be modified and/or combined, expressly or inherently teach every limitation of claim 96, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 96 in such a manner so as to arrive at the claimed subject matter of claim 96.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 96 is respectfully requested.

73. Claim 97

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

b. Missing Claim Limitations

Claim 97 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein data for a channel is received at the computer system and forwarded to the subscriber unit". The present Office Action alleges that Rogers teaches this claimed subject matter at "fig. 7a, step 702". Yet, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS" (emphasis added). No evidence is of record that one having ordinary skill in the art would have found that a "list" of "programs" teaches a "channel".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 97, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 97 in such a manner so as to arrive at the claimed subject matter of claim 97.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 97 is respectfully requested.

74. Claim 98

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 98, in such a manner so as to arrive at the claimed subject matter of claim 98. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 13, "it would have been obvious to an artisan to apply Acharya's teaching to Rogers's system with the motivation being to provide transmits data as a series of variable length packets, each having a circuit number that identifies its source and destination address."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 98 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 98 is respectfully requested.

75. Claim 99

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 99, in such a manner so as to arrive at the claimed subject matter of claim 99. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 13, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide packets only to the requested client over the multicast IP network."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus,

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 99 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 99 is respectfully requested.

76. Claim 100

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a prima facie case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 100 in such a manner so as to arrive at the claimed subject matter of claim 100.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 100 is respectfully requested.